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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/773,353	01/31/2001	Neil R.N. Enns	13768.178.1	4025

47973 7590 09/13/2005

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EXAMINER

HASHEM, LISA

ART UNIT	PAPER NUMBER
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2645

DATE MAILED: 09/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/773,353	Applicant(s) ENNS ET AL.	
	Examiner Lisa Hashem	Art Unit 2645	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-35, 37, 38, 40, 41, 43, and 44 is/are rejected.
- 7) ☒ Claim(s) 36, 39, 42 and 45 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 36, 39, 42, and 45 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, '**...wherein the progress indicator is a bar graph...**' which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In Figure 3 of the instant application, element 362 shows a progress indicator but there is no mention of the progress indicator being a bar graph in the specification (see Specification: page 13, lines 6-7).

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1, 10, 16, and 25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In the limitation, '**...wherein the total amount of audio content that may be stored in temporary storage is limited to a predetermined maximum...**', the term 'may be' is indefinite.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 1 recites the limitation "the data audio content". There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1-3, 6, 8, 16, 18, 22, 23, 25, 27, 30, 32, 34, 35, 40, 41, 43, and 44 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by U.S. Patent No. 6,760,696 by Goldberg et al, hereinafter Goldberg.

Regarding claim 1, Goldberg discloses in a computerized system that includes one or more mobile devices (Fig. 1A, 1B: 10) (e.g. personal data assistants, telephone, laptop computers, palm type computer, hand held personal computer, or handheld digital computer read on claimed mobile device because these devices are capable of being moved and are hand-held devices) and an electronic message server (e.g. personal computer) supporting wireless communication (col. 7, lines 13-18; col. 9, lines 24-27), wherein at least some of the mobile devices have an input system that is optimized for numeric input rather than text input (col. 2,

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lines 12-16), and wherein at least some of the mobile devices are capable of sending and receiving electronic messages (col. 7, lines 13-18; col. 7, lines 61-67), a method of composing an electronic message using a mobile device, the method comprising acts of: receiving a command to begin composing an electronic message at a mobile device; receiving a command to add audio content to the electronic message at the mobile device (col. 7, lines 61-67); diverting to a temporary storage within the mobile device, an audio content stream within the mobile device received at an audio input wherein the total amount of audio content that may be stored in temporary storage is limited to a predetermined maximum (col. 11, lines 3-15; col. 7, lines 55-57; col. 9, lines 45-60); displaying a progress indicator to show a current amount of temporary storage used in storing the audio content stream compared to the predetermined maximum (Fig. 4, 100; col. 9, lines 45-60); storing the audio content stream within the mobile device in a format that is compatible with adding audio content to the electronic message (col. 6, lines 27-37); and attaching the formatted audio content to the electronic message at the mobile device (col. 7, lines 61-67).

Regarding claim 3, a method as recited in claim 1, wherein Goldberg further discloses the electronic message comprises an electronic mail message, and wherein the formatted audio content is attached as an electronic mail attachment (col. 7, lines 61-67).

Regarding claim 6, a method as recited in claim 1, wherein Goldberg further discloses the format used to store the audio content stream allows for data compression, the method further comprising an act of compressing the audio content stream in accordance with the storage format (col. 6, lines 27-37; col. 6, lines 46-57; col. 11, lines 3-15).

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Regarding claim 8, a method as recited in claim 1, wherein Goldberg further discloses receiving the command to add audio content to the electronic message is based on either selection of a user interface menu item to add audio content to the electronic message or a press of a record button (col. 7, lines 61-67).

Regarding claim 16, 18, 22, and 23, please see the rejections to claims: 1, 3, 6, and (1 and 8), respectively, to reject the method in claims 16, 18, 22, and 23.

Regarding claim 25, please see the rejection to claim 1 above, to reject the computer program product in claim 25. Wherein Goldberg further discloses a computer program product for implementing a method of composing an electronic message using a mobile device (col. 5, lines 15-27), comprising: a computer readable medium for carrying machine-executable instructions for implementing the method (Fig. 1A, 12: CPU; col. 5, lines 28-43).

Regarding claims 27, 30, and 32, please see the rejections to claims 3, 6, and 8 above, respectively, to reject the computer program product in claims 27, 30, and 32.

Regarding claim 34, the method as recited in claim 1, wherein Goldberg further discloses the predetermined maximum is based on available communication bandwidth (col. 7, lines 52-57).

Regarding claim 35, the method as recited in claim 1, wherein Goldberg further discloses the predetermined maximum is based on an amount of available storage (col. 7, lines 52-57).

Regarding claims 40, 41, 43, and 44, please see the rejection to claims 34 and 35 above, respectively, to reject the method in claims 40 and 41 and the computer program product in claims 43 and 44.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 2, 4, 7, 17, 19, 26, 28, and 31 are rejected under 35 U.S.C. 103(a) as being obvious over Goldberg, and in further view of U.S. Patent No. 6,351,523 by Detlef.

The applied reference (Goldberg) has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention “by another”; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(l)(1) and § 706.02(l)(2).

Regarding claim 2, a method as recited in claim 1, wherein Goldberg further discloses the temporary storage comprises a temporary data file (col. 9, lines 24-27), and wherein the audio

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content stream received at the audio input is generated by a user speaking into the phone's mouthpiece (Fig. 1A, 30) (col. 6, lines 16-23).

Goldberg does not disclose the mobile device comprises a phone.

Detlef discloses in a computerized system (see Fig. 1) that includes one or more mobile devices or thin client devices (Fig. 1, 12; col. 3, lines 64-67) and an electronic message server (Fig. 1, 36) supporting wireless communication, wherein at least some of the mobile devices have an input system that is optimized for numeric input rather than text input (col. 1, lines 35-57), and wherein at least some of the mobile devices are capable of sending and receiving electronic messages (col. 3, lines 51-50), a method of composing an electronic message using a mobile device (see Abstract and Fig. 2, 12), the method comprising acts of: receiving a command to begin composing an electronic message at a mobile device; receiving a command to add audio content to the electronic message at the mobile device; inherently diverting to a temporary storage within the mobile device, an audio content stream within the mobile device received at an audio input; storing the audio content stream in a format that is compatible with adding audio content to the electronic message; and attaching the formatted audio content to the electronic message at the mobile device (col. 1, lines 58-63; col. 4, lines 30-40; col. 5, lines 13-25).

Detlef further discloses the mobile device comprises a phone (Fig. 2, 12) and the temporary storage inherently comprises a temporary data, and wherein the audio content stream received at the audio input is generated by a user speaking into the phone's mouthpiece (col. 1, lines 58-63; col. 4, lines 30-40; col. 5, lines 13-25).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Goldberg to include the mobile device comprises a phone as

taught by Detlef. One of ordinary skill in the art would have been lead to make such a modification to utilize a telephonic communication device to compose an electronic message.

Regarding claim 4, a method as recited in claim 3, wherein Goldberg does not disclose the electronic mail message is composed in either replying to or forwarding a specific electronic mail message, the method further comprising an act of receiving the specific electronic mail message.

Detlef discloses in a computerized system (see Fig. 1) that includes one or more mobile devices or thin client devices (Fig. 1, 12; col. 3, lines 64-67) and an electronic message server (Fig. 1, 36) supporting wireless communication, wherein at least some of the mobile devices have an input system that is optimized for numeric input rather than text input (col. 1, lines 35-57), and wherein at least some of the mobile devices are capable of sending and receiving electronic messages (col. 3, lines 51-50), a method of composing an electronic message using a mobile device (see Abstract and Fig. 2, 12), the method comprising acts of: receiving a command to begin composing an electronic message at a mobile device; receiving a command to add audio content to the electronic message at the mobile device; inherently diverting to a temporary storage within the mobile device, an audio content stream within the mobile device received at an audio input; storing the audio content stream in a format that is compatible with adding audio content to the electronic message; and attaching the formatted audio content to the electronic message at the mobile device (col. 1, lines 58-63; col. 4, lines 30-40; col. 5, lines 13-25).

Detlef further discloses the electronic mail message is composed in either replying to or forwarding a specific electronic mail message, the method further comprising an act of receiving the specific electronic mail message (col. 4, lines 30-40; col. 5, lines 13-25).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Goldberg to include the electronic mail message is composed in either replying to or forwarding a specific electronic mail message, the method further comprising an act of receiving the specific electronic mail message as taught by Detlef. One of ordinary skill in the art would have been lead to make such a modification to attach audio content stream to an electronic mail message in response to a specific electronic mail message that is received at the mobile device.

Regarding claim 7, a method as recited in claim 6, wherein Goldberg does not disclose the storage format is a WAV file format.

Detlef discloses in a computerized system (see Fig. 1) that includes one or more mobile devices or thin client devices (Fig. 1, 12; col. 3, lines 64-67) and an electronic message server (Fig. 1, 36) supporting wireless communication, wherein at least some of the mobile devices have an input system that is optimized for numeric input rather than text input (col. 1, lines 35-57), and wherein at least some of the mobile devices are capable of sending and receiving electronic messages (col. 3, lines 51-50), a method of composing an electronic message using a mobile device (see Abstract and Fig. 2, 12), the method comprising acts of: receiving a command to begin composing an electronic message at a mobile device; receiving a command to add audio content to the electronic message at the mobile device; inherently diverting to a temporary storage within the mobile device, an audio content stream within the mobile device received at an audio input; storing the audio content stream in a format that is compatible with adding audio content to the electronic message; and attaching the formatted audio content to the electronic message at the mobile device (col. 1, lines 58-63; col. 4, lines 30-40; col. 5, lines 13-25).

Detlef further discloses the storage format is a WAV file format (col. 5, lines 13-25).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Goldberg to include the storage format is a WAV file format as taught by Detlef. One of ordinary skill in the art would have been lead to make such a modification compress the audio content stream in a WAV file format form that is compatible with adding audio content to the electronic message.

Regarding claims 17 and 19, please see the rejections to claims 2 and 4 above, respectively, to reject the method in claims 17 and 19.

Regarding claims 26, 28, and 31, please see the rejections to claim 2, 4, and 7 above, reject the computer program product in claims 26, 28, and 31.

11. Claims 9, 24, and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldberg, and in further view of U.S. Patent Application Publication No. US 2001/0045885 by Tett.

The applied reference (Goldberg) has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that

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the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(l)(1) and § 706.02(l)(2).

Regarding claim 9, a method as recited in claim 1, wherein Goldberg does not disclose comprising acts of: displaying an indicator that audio content has been attached to the electronic message; and displaying a size of the attached audio content.

Tett discloses a method of composing an electronic message using a mobile device (section 0023, lines 1-7; section 0024, lines 9-11; section 0025, lines 1-14) comprising: composing an electronic message; adding audio content to the electronic message; and attaching the audio content to the electronic message (section 0032, lines 1-16). Wherein, Tett discloses acts of: displaying an indicator that audio content has been attached to the electronic message; and displaying a size of the attached audio content (see Fig 2, 214; section 0032, lines 1-16).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Goldberg to include displaying an indicator that audio content has been attached to the electronic message and displaying a size of the attached audio content as taught by Tett. One of ordinary skill in the art would have been lead to make such a modification since the user of the mobile device can view the attachment and determine its size on the display of said device.

Regarding claim 24, please see the rejection to claim 9 above, to reject the method in claim 24.

Regarding claim 33, please see the rejection to claim 9 above, to reject the computer program product in claim 33.

12. Claims 10-13, 37, and 38 are rejected under 35 U.S.C. 103(a) as being obvious over Goldberg in further view of Detlef.

Regarding claim 10, Goldberg discloses in a computerized system that includes one or more mobile devices (Fig. 1A, 1B: 10) (e.g. personal data assistants, telephone, laptop computers, palm type computer, hand held personal computer, or handheld digital computer read on claimed mobile device because these devices are capable of being moved and are hand-held devices) and an electronic message server (e.g. personal computer) supporting wireless communication (col. 7, lines 13-18; col. 9, lines 24-27), wherein at least some of the mobile devices have an input system that is optimized for numeric input rather than text input (col. 2, lines 12-16), and wherein at least some of the mobile devices are capable of sending and receiving electronic messages (col. 7, lines 13-18; col. 7, lines 61-67), a method of composing an electronic message using a mobile device, the method comprising acts of: receiving a command to begin composing an electronic message at a mobile device; receiving a command to add audio content to the electronic message at the mobile device (col. 7, lines 61-67); diverting to a temporary storage within the mobile device, an audio content stream within the mobile device received at an audio input wherein the total amount of audio content that may be stored in temporary storage is limited to a predetermined maximum (col. 11, lines 3-15; col. 7, lines 55-57; col. 9, lines 45-60); displaying a progress indicator to show a current amount of temporary storage used in storing the audio content stream compared to the predetermined maximum (Fig. 4, 100; col. 9, lines 45-60); storing the audio content stream within the mobile device in a format

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that is compatible with adding audio content to the electronic message (col. 6, lines 27-37); and attaching the formatted audio content to the electronic message at the mobile device (col. 7, lines 61-67).

Goldberg does not disclose composing an electronic mail message at a wireless telephone.

Detlef discloses in a computerized system (see Fig. 1) that includes one or more mobile devices or thin client devices (Fig. 1, 12; col. 3, lines 64-67) and an electronic message server (Fig. 1, 36) supporting wireless communication, wherein at least some of the mobile devices have an input system that is optimized for numeric input rather than text input (col. 1, lines 35-57), and wherein at least some of the mobile devices are capable of sending and receiving electronic messages (col. 3, lines 51-50), a method of composing an electronic message using a wireless telephone (see Abstract and Fig. 2, 12; col. 3, lines 64-67), the method comprising acts of: receiving a command to begin composing an electronic message at a wireless telephone; receiving a command to add audio content to the electronic message at the wireless telephone; inherently diverting to a temporary storage within the wireless telephone, an audio content stream within the wireless telephone received at an audio input; storing the audio content stream in a format that is compatible with adding audio content to the electronic message; and attaching the formatted audio content to the electronic message at the wireless telephone (col. 1, lines 58-63; col. 4, lines 30-40; col. 5, lines 13-25).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Goldberg to include composing an electronic mail message at a wireless telephone as taught by Detlef. One of ordinary skill in the art would have been lead to

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make such a modification to utilize a telephonic communication device to compose an electronic message.

Regarding claim 11, a method as recited in claim 10 wherein Detlef further discloses the electronic mail message is composed in either replying to or forwarding a specific electronic mail message, the method further comprising an act of receiving the specific electronic mail message (col. 4, lines 30-40; col. 5, lines 13-25).

Regarding claim 12, a method as recited in claim 10, wherein Detlef further discloses the attaching the formatted audio content to the electronic mail message inherently complies with a Multipurpose Internet Mail Extensions specification (col. 1, lines 58-63; col. 4, lines 30-40; col. 5, lines 13-25).

Regarding claim 13, a method as recited in claim 10, wherein Goldberg further discloses the format used to store the audio content stream allows for data compression, the method further comprising an act of compressing the audio content stream in accordance with the storage format (col. 6, lines 27-37; col. 6, lines 46-57; col. 11, lines 3-15).

Regarding claim 37, the method as recited in claim 10, wherein Goldberg further discloses the predetermined maximum is based on available communication bandwidth (col. 7, lines 52-57).

Regarding claim 38, the method as recited in claim 10, wherein Goldberg further discloses the predetermined maximum is based on an amount of available storage (col. 7, lines 52-57).

13. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Goldberg in view of Detlef, as applied to claim 10, and in further view of Tett.

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Regarding claim 15, a method as recited in claim 1, wherein Goldberg further discloses receiving the command to add audio content to the electronic message is based on either selection of a user interface menu item to add audio content to the electronic message or a press of a record button (col. 7, lines 61-67).

Goldberg in view of Detlef do not disclose comprising acts of: displaying an indicator that audio content has been attached to the electronic message; and displaying a size of the attached audio content.

Tett discloses a method of composing an electronic message using a mobile device (section 0023, lines 1-7; section 0024, lines 9-11; section 0025, lines 1-14) comprising: composing an electronic message; adding audio content to the electronic message; and attaching the audio content to the electronic message (section 0032, lines 1-16). Wherein, Tett discloses acts of: displaying an indicator that audio content has been attached to the electronic message; and displaying a size of the attached audio content (see Fig 2, 214; section 0032, lines 1-16).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Goldberg in view of Detlef to include displaying an indicator that audio content has been attached to the electronic message and displaying a size of the attached audio content as taught by Tett. One of ordinary skill in the art would have been lead to make such a modification since the user of the mobile device can view the attachment and determine its size on the display of said device.

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 1-3, 6-8, 10-13, 16-18, 22, 23, 25-27, 30-32, 34, 35, 37, 38, 40, 41, 43, and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,222,909 by Qua et al, hereinafter Qua, in further view of U.S. Patent No. 6,453,281 by Walters et al, hereinafter Walters.

Regarding claim 1, Qua discloses in a computerized system that includes one or more mobile devices (Fig. 1: 110, 150; col. 1, lines 11-22) (e.g. wireless terminals read on claimed mobile device because these devices are capable of being moved) and an electronic message server (e.g. e-mail server) supporting wireless communication (col. 1, lines 45-49; col. 2, lines 64-67), wherein at least some of the mobile devices have an input system that is optimized for numeric input rather than text input (col. 6, line 67 – col. 7, line 6), and wherein at least some of the mobile devices are capable of sending and receiving electronic messages (col. 2, lines 5-8; col. 8, lines 3-8), a method of composing an electronic message using a mobile device, the method comprising acts of: receiving a command to begin composing an electronic message at a mobile device (col. 7, lines 55-56); receiving a command to add audio content to the electronic message at the mobile device (col. 5, lines 55-66); diverting to a temporary storage within the mobile device (Fig. 1, 120), an audio content stream within the mobile device received at an audio input wherein the total amount of audio content that may be stored in temporary

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storage is limited to a predetermined maximum (col. 4, lines 40-56); displaying a progress indicator to show a current recording of the audio content stream (Fig. 4, 440; col. 7, lines 18-19); storing the audio content stream within the mobile device in a format that is compatible with adding audio content to the electronic message (col. 7, lines 6-10); and attaching the formatted audio content to the electronic message at the mobile device (col. 5, lines 55-62; col. 7, lines 55-56).

Qua does not disclose displaying a progress indicator to show a current amount of temporary storage used in storing the audio content stream compared to the predetermined maximum.

Walters discloses a method of recording an audio content stream using a mobile device (Fig. 1, 40; col. 1, lines 63-65; col. 4, lines 17-22) (e.g. portable audio database device reads on claimed mobile device because this device is capable of being moved and are hand-held devices), the method comprising acts of:

receiving a command to begin recording audio content stream at a mobile device (col. 5, lines 9-12);

diverting to a temporary storage within the mobile device (Fig. 4, 122), an audio content stream within the mobile device received at an audio input wherein the total amount of audio content that may be stored in temporary storage is limited to a predetermined maximum (col. 4, lines 23-25; col. 6, lines 49-53; col. 7, lines 29-33);

displaying a progress indicator to show a current amount of temporary storage used in storing the audio content stream compared to the predetermined maximum (Fig. 17D, 101; col. 6, lines 49-53; col. 7, lines 29-33);

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storing the audio content stream within the mobile device in a format that is compressed (col. 8, line 58 – col. 9, line 24).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Qua to include displaying a progress indicator to show a current amount of temporary storage used in storing the audio content stream compared to the predetermined maximum as taught by Walters. One of ordinary skill in the art would have been lead to make such a modification to display a progress indicator to show the amount of temporary storage used.

Regarding claim 2, a method as recited in claim 1, wherein Qua further discloses the mobile device comprises a phone (col. 1, lines 40-45; col. 2, lines 49-63) and the temporary storage comprises a temporary data file (col. 4, lines 40-56), and wherein the audio content stream received at the audio input is generated by a user inherently speaking into the phone's mouthpiece (col. 3, lines 22-39; col. 4, lines 4-25).

Regarding claim 3, a method as recited in claim 1, wherein Qua further discloses the electronic message comprises an electronic mail message, and wherein the formatted audio content is attached as an electronic mail attachment (col. 2, lines 5-8; col. 5, lines 43-62).

Regarding claim 6, a method as recited in claim 1, wherein Qua further discloses the format used to store the audio content stream allows for data compression, the method further comprising an act of compressing the audio content stream in accordance with the storage format (col. 5, lines 55-62; col. 7, lines 6-10).

Regarding claim 7, a method as recited in claim 6, wherein Walters further discloses the storage format is a WAV file format (col. 9, lines 10-13).

Regarding claim 8, a method as recited in claim 1, wherein Qua further discloses receiving the command to add audio content to the electronic message is based on either selection of a user interface menu item to add audio content to the electronic message or a press of a record button (col. 7, lines 55-56).

Regarding claim 10, please see the rejections above to claims 1 and 2 to reject the method in claim 10.

Regarding claims 12 and 13, a method as recited in claim 10, wherein please see the rejections above to claims 3 and 6, respectively, to reject the method in claims 12 and 13.

Regarding claims 16-18, 22, and 23, please see the rejections to claims 1, 2, 3, 6, and (1 and 8) above, respectively, to reject the method in claims 16-18, 22, and 23.

Regarding claim 25, please see the rejection to claim 1 above, to reject the computer program product in claim 25. Wherein Walters further discloses a computer program product for implementing a method of composing an electronic message using a mobile device (col. 3, lines 58-62), comprising: a computer readable medium for carrying machine-executable instructions for implementing the method (Fig. 4, 120: CPU; col. 7, lines 29-33; col., 8, line 58 – col. 9, line 40).

Regarding claims 26, 27, 30, 31, and 32, please see the rejections to claims 2, 3, 6, 7, and 8 above, to reject the computer program product in claims 26, 27, 30, 31, and 32.

Regarding claim 34, the method as recited in claim 1, wherein Qua further discloses the predetermined maximum is based on available communication bandwidth (col. 5, lines 16-25).

Regarding claim 35, the method as recited in claim 1, wherein Walters further discloses the predetermined maximum is based on an amount of available storage (col. 6, lines 49-53).

Regarding claims 37, 38, 40, 41, 43, and 44, please see the rejection to claims 34 and 35 above, respectively, to reject the method in claims 37, 38, 40, and 41 and the computer program product in claims 43 and 44.

16. Claims 4, 11, 19, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Qua in view of Walters, and in further view of Detlef.

Regarding claim 4, a method as recited in claim 3, wherein Qua in view of Walters do not disclose the electronic mail message is composed in either replying to or forwarding a specific electronic mail message, the method further comprising an act of receiving the specific electronic mail message.

Detlef discloses in a computerized system (see Fig. 1) that includes one or more mobile devices or thin client devices (Fig. 1, 12; col. 3, lines 64-67) and an electronic message server (Fig. 1, 36) supporting wireless communication, wherein at least some of the mobile devices have an input system that is optimized for numeric input rather than text input (col. 1, lines 35-57), and wherein at least some of the mobile devices are capable of sending and receiving electronic messages (col. 3, lines 51-50), a method of composing an electronic message using a mobile device (see Abstract and Fig. 2, 12), the method comprising acts of: receiving a command to begin composing an electronic message at a mobile device; receiving a command to add audio content to the electronic message at the mobile device; inherently diverting to a temporary storage within the mobile device, an audio content stream within the mobile device received at an audio input; storing the audio content stream in a format that is compatible with adding audio content to the electronic message; and attaching the formatted audio content to the electronic message at the mobile device (col. 1, lines 58-63; col. 4, lines 30-40; col. 5, lines 13-25).

Detlef further discloses the electronic mail message is composed in either replying to or forwarding a specific electronic mail message, the method further comprising an act of receiving the specific electronic mail message (col. 4, lines 30-40; col. 5, lines 13-25).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Qua in view of Walters to include the electronic mail message is composed in either replying to or forwarding a specific electronic mail message, the method further comprising an act of receiving the specific electronic mail message as taught by Detlef. One of ordinary skill in the art would have been lead to make such a modification to attach audio content stream to an electronic mail message in response to a specific electronic mail message that is received at the mobile device.

Regarding claim 11, please see the rejection to claim 4 above, to reject the method in claim 11.

Regarding claim 19, please see the rejection to claim 4 above, to reject the method in claim 19.

Regarding claim 28, please see the rejection to claim 4 above, to reject the computer program product in claim 28.

17. Claims 9, 15, 24, and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Qua in view of Walters, and in further view of Tett.

Regarding claim 9, a method as recited in claim 1, wherein Qua in view of Walters do not disclose comprising acts of: displaying an indicator that audio content has been attached to the electronic message; and displaying a size of the attached audio content.

Tett discloses a method of composing an electronic message using a mobile device (section 0023, lines 1-7; section 0024, lines 9-11; section 0025, lines 1-14) comprising: composing an electronic message; adding audio content to the electronic message; and attaching the audio content to the electronic message (section 0032, lines 1-16). Wherein, Tett discloses acts of: displaying an indicator that audio content has been attached to the electronic message; and displaying a size of the attached audio content (see Fig 2, 214; section 0032, lines 1-16).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Qua in view of Walters to include displaying an indicator that audio content has been attached to the electronic message and displaying a size of the attached audio content as taught by Tett. One of ordinary skill in the art would have been lead to make such a modification since the user of the mobile device can view the attachment and determine its size on the display of said device.

Regarding claim 15, a method as recited in claim 10, wherein Qua further discloses receiving the command to add audio content to the electronic message is based on either selection of a user interface menu item to add audio content to the electronic message or a press of a record button (col. 7, lines 55-56).

Qua in view of Walters do not disclose comprising acts of: displaying an indicator that audio content has been attached to the electronic message; and displaying a size of the attached audio content.

Tett discloses a method of composing an electronic message using a mobile device (section 0023, lines 1-7; section 0024, lines 9-11; section 0025, lines 1-14) comprising: composing an electronic message; adding audio content to the electronic message; and attaching

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the audio content to the electronic message (section 0032, lines 1-16). Wherein, Tett discloses acts of: displaying an indicator that audio content has been attached to the electronic message; and displaying a size of the attached audio content (see Fig 2, 214; section 0032, lines 1-16).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Qua in view of Walters to include displaying an indicator that audio content has been attached to the electronic message and displaying a size of the attached audio content as taught by Tett. One of ordinary skill in the art would have been lead to make such a modification since the user of the mobile device can view the attachment and determine its size on the display of said device.

Regarding claim 24, please see the rejection to claim 9 above, to reject the method in claim 24.

Regarding claim 33, please see the rejection to claim 9 above, to reject the computer program product in claim 33.

Response to Arguments

18. Applicant's arguments, see Amendment, filed 4-27-2005, with respect to the rejection(s) of claim(s) 1-45 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made of claims 1-45. Please see all rejections above.

19. Accordingly, this action is **NON-FINAL**.

Conclusion

20. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- U.S. Patent No. 6,038,199 by Pawlowski et al disclose a method of recording an audio content stream on a portable digital audio recorder

21. Any response to this action should be mailed to:

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Or faxed to:

(571) 273-8300 (for formal communications intended for entry)

Or call:

(571) 272-2600 (for customer service assistance)

22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lisa Hashem whose telephone number is (571) 272-7542. The examiner can normally be reached on M-F 8:30-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (571) 272-7547. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-2600.

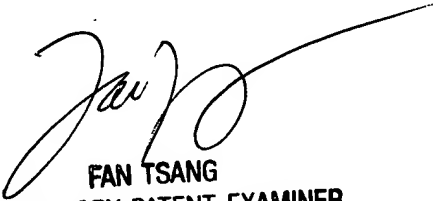
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23. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

LH

lh

September 1, 2005


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